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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,472	10/22/2001	John R. Havens	266/115	6158

34263 7590 09/15/2003

O'MELVENY & MEYERS  
114 PACIFICA, SUITE 100  
IRVINE, CA 92618

EXAMINER
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FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/029,472		HAVENS ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	BJ Forman		1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

***Preliminary Amendment***

1. The preliminary amendment filed 22 October 2001 is acknowledged. Claims 2-24 are canceled. Claim 1 is pending.

***Specification***

2. The specification is objected to because the title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Micro-electronic device for receiving a solution.

***Claim Objections***

3. Claim is objected to because of the following informalities:
  - a. In line 1, "receive" is misspelled.
  - b. In line 3, "and" is inappropriately recited after "substrate;".Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Heller et al (U.S. Patent No. 5,632,957, issued 27 May 1997).

Regarding Claim 1, Heller et al discloses an electronic device adapted to receive a solution comprising: a substrate, a plurality of selectively addressable electrodes on the substrate, a permeation layer adjacent the electrodes, the permeation layer being a sol-gel composition and an electric source for selectively addressing the electrodes (Claim 13 and Column 10, lines 10-17).

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Heller et al (U.S. Patent No. 5,849, 486, issued 15 December 1998).

Regarding Claim 1, Heller et al discloses an electronic device adapted to receive a solution comprising: a substrate, a plurality of selectively addressable electrodes on the substrate, a permeation layer adjacent the electrodes, the permeation layer being a sol-gel composition and an electric source for selectively addressing the electrodes (Column 9, line 66-Column 11, line 22 and Column 12, lines 24-32).

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7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Sosnowski et al (U.S. Patent No. 6,051,380, issued 18 April 2000).

Regarding Claim 1, Sosnowski et al discloses an electronic device adapted to receive a solution comprising: a substrate, a plurality of selectively addressable electrodes on the substrate, a permeation layer adjacent the electrodes, the permeation layer being a sol-gel composition and an electric source for selectively addressing the electrodes (Column 14, line 45-Column 15, line 55 and Column 22, lines 1-22).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,306,348. Although the conflicting claims are not identical, they are not patentably distinct from each other because they only differ in the instant claim recites "a permeation layer adjacent the electrode" while the '348 claim recites "a permeation layer overlaying the electrode". However, the patented

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overlying permeation layer is also adjacent to the electrode. Therefore, the instantly claimed adjacent permeation layer is obvious over that of the patented permeation layer.

10. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 13 of U.S. Patent No. 5,632,957. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims are drawn to a permeation layer and differ only in the instant claim limits the permeation layer to a sol-gel permeation layer. However, the '957 specification teaches that their claimed permeation layer is a sol-gel permeation layer (Column 10, lines 10-17). Therefore, the instantly claimed sol-gel permeation layer is obvious in view of the patent teaching of a sol-gel permeation layer.

### **Conclusion**

11. No claim is allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-8724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



BJ Forman, Ph.D.  
Primary Examiner  
Art Unit: 1634  
September 10, 2003